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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,034	04/23/2001	Gerardo Castillo	PROTEO.P07C1	4033

7590 12/19/2001
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EXAMINER

DELACROIX MUIRHEI, CYBILLE

ART UNIT PAPER NUMBER

1614

DATE MAILED: 12/19/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/786,034

Applicant(s)
CASTILLO et al.

Examiner
Cybille Delacroix-Muirheid

Art Unit
1614



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 5, 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2, 3, 5-11, and 13-19 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2, 3, 6, 8-11, 13, 16, 17, and 19 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 5, 7, 14, 15, and 18 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Art Unit: 1614

DETAILED ACTION

The following is responsive to Applicant's amendment received Oct. 5, 2001 and the declaration under 131(b) also received Oct. 5, 2001.

Claims 1, 4, 12 are cancelled. New claims 17-19 are added. Claims 2, 3, 5-11, 13-19 are currently pending.

The previous objection of claims 5, 7, 14, 15 as well as new claim 18 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The **intended therapeutic use** of the claimed compositions, e.g. for treating amyloidoses, does not limit the **physical/structural aspects** of the claimed compositions.

1. The previous rejection of claims 1, 4, 5, 6, 7, 12, 14, 15 under 35 USC 102(e) set forth in paragraph 6 of the office action mailed July 3, 2001 **is withdrawn** in view of Applicant's amendment which **cancels** the relevant claims. The declaration filed on Oct. 5, 2001 under 37 CFR 1.131 has been considered but was ineffective to overcome the Hastings et al. reference.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Hastings et al. reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler*

Art Unit: 1614

v. Scudder, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). It appears from Applicant's declaration that conception occurred after the 102(e) filing date (March 11, 1998) of the Hastings et al. patent. The statements in paragraph 4, which pertain to the inventive compositions of the instant application, appear to indicate that conception occurred sometime between May 15, 1998 and August 30, 1998, which is after the filing date of the Hastings et al. patent. Moreover, the declaration does not establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Hastings et al. reference. Constructive reduction to practice for the instant invention appears to have been when the provisional application was filed August 30, 1998 which is after the filing date of the Hastings et al. reference.

Allowable Subject Matter

Claims 2-3, 5-11, 13-19 are free from the prior art because the prior art does not disclose or fairly suggest Applicant's claimed compositions and methods.

Conclusion

Claims 5, 7, 14, 15 and 18 are objected to under 37 CFR 1.75(c).

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1614

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cybille Delacroix-Muirheid whose telephone number is (703) 306-3227. The examiner can normally be reached on Tue-Fri from 8:30 to 6:00. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel, can be reached on (703) 308-4725. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

CDM



Dec. 17, 2001

ZONKREY
PRIMARY EXAMINER
GROUP 1200

